

REMARKS

I. Introduction

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 1-15 Under 35 U.S.C. § 103

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura et al. (JP 63-316405) in view of Wada et al (USP No. 3,725,836). Applicants respectfully submit that Nakamura and Wada fail to render the pending claims obvious for at least the following reasons.

With regard to the present disclosure, independent claim 1 recites a static electricity countermeasure component comprising a varistor layer and a board laminated with the varistor layer. The varistor layer comprises a material including at least bismuth oxide. The bismuth oxide is diffused to the board by sintering the varistor layer and the board. In addition, a bismuth oxide diffusing layer is provided at the board.

It was admitted that Nakamura fails to teach or suggest a varistor layer comprising at least bismuth oxide, that the bismuth oxide is diffused to the board by sintering the varistor layer and the board, and that a bismuth oxide diffusing layer is provided at the board. Wada was found to remedy these deficiencies. Applicants respectfully disagree.

It is stated in the Office Action that col. 3, lines 20-52 of Wada teach the above-mentioned limitations deficient in Nakamura. However, a review of this passage shows that this is not so. Wada teaches that the varistor paste applied to the insulating base is dried, if necessary, to remove the liquid vehicle and then fired. The preferred firing temperature is 400 to

850 °C (see, col. 3, lines 20-28 of Wada). Thus, Wada teaches that the varistor paste is not sintered after application to the board, but rather it is merely fired at 400 to 850 °C after application to the board. The only mention of sintering in the cited passage of Wada is in the preparation of finely divided zinc oxide powder (which may include additives such as bismuth oxide) in which the zinc oxide is sintered at 1100 to 1500 °C and then pulverized (see, col. 3, lines 29-31 and lines 41-51). However, this portion of the passage does not refer to the application of the varistor paste to the board. In fact, in the preparation of the varistor paste, the zinc oxide and bismuth oxide will be strongly bound to each other after sintering. Therefore, after the paste is applied to the board, subsequent firing at a 400-850 °C will not be sufficient to separate the bismuth oxide from the zinc oxide and diffuse to the board. Accordingly, Wada fails to teach or suggest that bismuth oxide is diffused to the board by sintering the varistor layer and the board. As such, the combination of Nakamura and Wada fails to teach or suggest all of the limitations of claim 1 of the present disclosure.

As is well known, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As Nakamura and Wada do not disclose a static electricity countermeasure component comprising a varistor layer; and a board laminated with the varistor layer; wherein the varistor layer comprises a material including at least bismuth oxide, the bismuth oxide is diffused to the board by sintering the varistor layer and the board, and a bismuth oxide diffusing layer is provided at the board, it is apparent that Nakamura and Wada fail to render claim 1 or any dependent claims thereon obvious. As such, claim 1 is allowable and patentable over the cited prior art and accordingly, the Applicants respectfully request that the § 103 rejection be withdrawn.

**III. All Dependent Claims Are Allowable Because The
Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having responded to all open issues set forth in the Office Action, it is respectfully submitted that all claims are in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Michael E. Fogarty
Registration No. 36,139

**Please recognize our Customer No. 53080
as our correspondence address.**

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF:NDM
Facsimile: 202.756.8087
Date: February 18, 2010